72 January 12. Argued Contracts for P.E. Carpenter, Contra

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TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

No. ~~432~~ 863

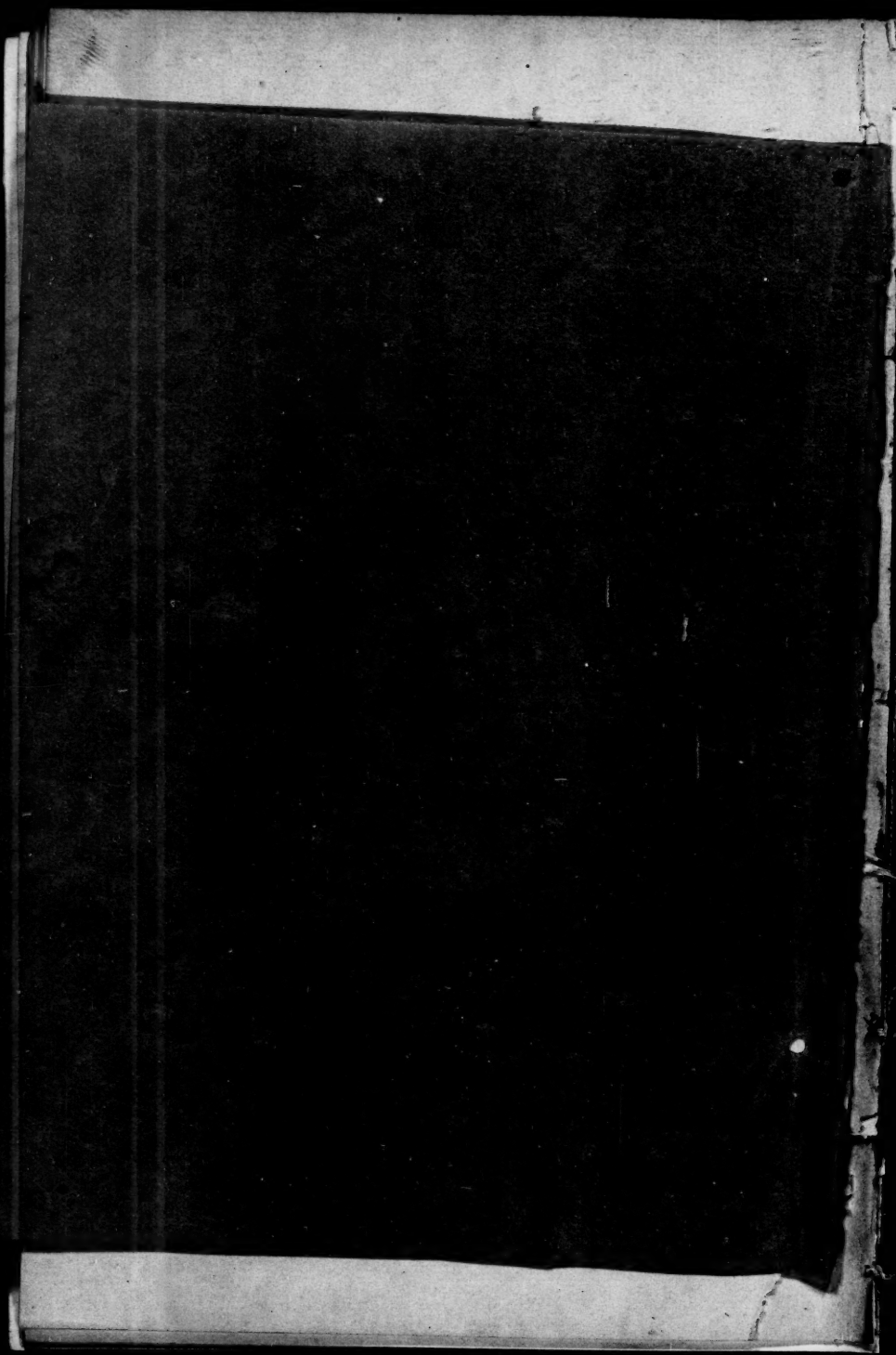
THE NICHOLSON PAVEMENT COMPANY, PLAINTIFF IN ERROR,

vs.

CHARLES E. JENKINS.

IN ERROR TO THE CIRCUIT COURT OF THE UNITED STATES FOR THE DISTRICT OF CALIFORNIA.

FILED SEPTEMBER 6, 1870.



SUPREME COURT OF THE UNITED STATES.

No. 482.

THE NICHOLSON PAVEMENT COMPANY, PLAINTIFF IN ERROR,

vs.

CHARLES E. JENKINS.

IN ERROR TO THE CIRCUIT COURT OF THE UNITED STATES FOR THE DISTRICT OF CALIFORNIA.

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1 UNITED STATES OF AMERICA, *ss:*

The President of the United States of America to the judges of the circuit court of the United States for the district of California, greeting:

Because in the record and proceedings, and also in the rendition of the judgment of a plea which is in the said circuit court before you, between Charles E. Jenkins and The Nicolson Pavement Company, a manifest error hath happened, to the great damage of the said "The Nicolson Pavement Company," as by its complaint appears, and it being fit that the error, if any there hath been, should be duly corrected, and full and speedy justice done to the parties aforesaid in this behalf, you are hereby commanded, if judgment be therein given, that then, under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the Supreme Court of the United States, together with this writ, so that
2 you have the same at Washington on the first Monday of December next, in the said Supreme Court to be there and then held, that, the record and proceedings aforesaid being inspected, the said Supreme Court may cause further to be done therein to correct that error what of right and according to the law and custom of the United States should be done.

Witness the Honorable Salmon P. Chase, Chief Justice of the said Supreme Court of the United States this 25th day of June, A. D. 1870, and of the independence of the United States the ninety-fourth.

[SEAL.] GEO. E. WHITNEY,
Clerk U. S. Circuit Court, Dist. of California.

The above writ of error is hereby allowed.

The answer of the judges of the circuit court of the United States for the district of California:

The record and all proceedings of the plaint whereof mention is within made, with all things touching the same, we certify under the seal of our said court to the Supreme Court of the United States within
3 mentioned, at the day and place within contained in a certain schedule to this writ annexed, as within we are commanded.

By the court:

[SEAL.] GEO. E. WHITNEY, *Clerk.*

4 (Indorsed:) Supreme Court of the United States. The Nicolson Pavement Company, plaintiff in error, vs. Charles E. Jenkins, defendant in error. Writ of error.

Filed 25 June, 1870.

GEO. E. WHITNEY, *Clerk.*

5 *Comlpaint.*

In the circuit court of the United States for the district of California.

CHARLES E. JENKINS
vs.
THE NICOLSON PAVEMENT COMPANY.

Charles E. Jenkins, the plaintiff in this action, by Sharpstein and

Hastings, his attorneys, complains of The Nicolson Pavement Company, a corporation incorporated under the laws of the State of California, having its principal place of business in the city and county of San Francisco in said district of California, defendant in this action, of a plea of trespass on the case: For that whereas, heretofore, and at the time of the granting of the letters-patent hereinafter mentioned, and before the committing of the grievances hereinafter mentioned, to wit, on the eighth day of August, in the year one thousand eight hundred and fifty-four, Samuel Nicolson, of the city of Boston, State of Massachusetts, was a citizen of the United States, and the true, first, and original inventor of a certain new and useful improvement in wooden pavements, *in wooden pavements*, mentioned and fully described in the letters-patent hereinafter mentioned, which new and useful improvement was not known or used by others before the invention thereof by the said Samuel Nicolson, and was not, at the time of the application
6 of the said Samuel Nicholson for a patent therefor, as hereinafter mentioned, in public use or on sale with the consent or allowance of the said Samuel Nicolson, as the inventor of the same; and the said Samuel Nicholson having paid into the treasury of the United States the sum of thirty dollars, and made application, in writing, to the Commissioner of Patents of the United States, expressing a desire of obtaining an exclusive property in the said improvement, and praying that a patent might be granted therefor; and having delivered to the said Commissioner of Patents a written description of said improvement, and of the manner and process of making and constructing the same, in such full, clear, and exact terms, avoiding unnecessary prolixity, as to enable any person skilled in the art to which the said improvement appertains, or with which it is most nearly connected, to make and construct the same; and having in said description fully explained the principle and the several modes in which he had contemplated the application of that principle or character by which the said improvement might be distinguished from other inventions, and having in the said description particularly specified and pointed out the improvements which he claimed as his own invention or discovery, and having, furthermore, accompanied the whole with duplicate drawings and written references, the nature of the case admitting thereof, which descriptions and drawings were signed by the said Samuel Nicholson, and were attested by two witnesses, and were filed in the Patent Office of the United States, and having moreover furnished to the said Commissioner of Patents a model of said improvement of a convenient size to exhibit advantageously its several parts, the case admitting of a representation by model, and having made oath before a person authorized by
7 law to administer oaths, that he did verily believe that he was the original and first inventor or discoverer of the said improvement, and that he did not know or believe that the same had been previously known or used, and that he was a citizen of the United States, and having duly complied in all respects with all the necessary conditions and requisitions of the statutes of the United States in such case made and provided, prior to the granting of the letters-patent hereinafter mentioned, the said Commissioner of Patents granted and issued to the said Samuel Nicholson letters-patent for the said improvement, which letters-patent were issued from the Patent Office in the name of the United States and under the seal of said office, and were signed by Robert McClelland, the Secretary of the Interior, and were countersigned by C. Mason, the Commissioner of Patents, and were recorded, together

with the said descriptions, specifications, and drawings, in the Patent Office, in books kept for that purpose, and contained a short description or title of the said improvements, correctly indicating its nature and design, and in their terms granted to the said Samuel Nicolson, his heirs, administrators, executors, or assigns, for the term of fourteen years from the eighth day of August, one thousand eight hundred and fifty-four, the full and exclusive right and liberty of making and constructing, and vending to others the right to make and construct, the said improvement, referring to the said specifications for the particulars thereof, a copy of which was annexed to the said letters-patent, specifying what the said Samuel Nicholson claimed as his invention, and were delivered to the said Samuel Nicholson, and bore date the eigth day of August, in the year one thousand eight hundred and fifty-four, all of which
8 was done under and according to provisions of the acts of Congress in such case made and provided, as by the said letters-patent, descriptions, specifications, and drawings, or a duly-certified copy thereof, which is hereby brought into court, will appear.

That afterwards, to wit, on the twentieth day of August, one thousand eight hundred and sixty-seven, upon the due application of the said Samuel Nicholson, the Commissioner of Patents duly caused a new patent to be issued to the said Samuel Nicholson for the said invention above mentioned for the residue of the period then unexpired, for which the original patent for said invention was granted, in accordance with the said Samuel Nicholson's corrected description and specification.

That afterwards, to wit, on the sixth day of January, one thousand eight hundred and sixty-eight, the said Samuel Nicholson died, at said city of Boston, intestate, and one George T. Bigelow, was, on the third day of February, one thousand eight hundred and sixty-eight, duly appointed and qualified as administrator of the estate of said Samuel Nicolson, deceased, as aforesaid, and has from thence hitherto acted, and still continues to act, as the administrator of said estate.

And afterwards, to wit, on the seventh day of July, one thousand eight hundred and sixty-eight, upon due application of the said George T. Bigelow, in his said capacity as administrator of the estate of said Samuel Nicolson, the Commissioner of Patents duly renewed and extended the said patent for the term of seven years from *from* and after the expiration of the said term of fourteen years for which the said patent was originally granted, the certificate whereof was duly made and entered of record on the day and year last aforesaid, as by the
9 said certificate, or a duly certified copy thereof, which is brought into court, will appear.

That afterwards, to wit, on the fourteenth day of August, one thousand eight hundred and sixty-eight, the said George T. Bigelow, by his deed of assignment, duly executed under his hand and seal, assigned, sold, and set over unto Edwin C. Larned and Stephen A. Goodwin, both of the city of Chicago, and State of Illinois, one-third of the right, title, and interest in said invention and patent in the State of California, which said assignment is duly recorded in said Patent Office.

That afterwards, to wit, on the fourteenth day of August, one thousand eight hundred and sixty-eight, the said George T. Bigelow, administrator as aforesaid, and the said Edwin C. Larned and the said Stephen A. Goodwin, by their deed of assignment, duly executed under their hands and seals, assigned, sold, and set over unto one Jonathan Taylor and this plaintiff, all their right, title, and interest in said

invention and patent in the said State of California, which said assignment is duly recorded in said Patent Office.

That afterwards, to wit, on the twenty-seventh day of February, one thousand eight hundred and sixty-nine, the said Jonathan Taylor, by his deed of assignment duly executed under his hand and seal, assigned, sold, and set over unto this plaintiff all his right, title, and interest in said invention and patent, in the said State of California, which said assignment is duly recorded in said Patent Office.

That said patent is of great value, to wit, the value of one million dollars, and the right, title, and interest of said plaintiff in said
10 invention for the said State of California is of great value, to wit, the value of fifty thousand dollars.

Yet the said defendant, well knowing the premises aforesaid, and contriving and wrongfully and injuriously intending to injure the said plaintiff, and to deprive him of the profits, benefits, and advantages which he might and otherwise would have derived and acquired from making and vending to others the right to make the said improvement, after the extension of said patent, and prior to the commencement of this action, to wit, on the first day of September, one thousand eight hundred and sixty-eight, and on divers days and times between that day and the commencement of this action, at the city of San Francisco, in said State of California, to wit, in said district of California, wrongfully, and without the leave or license and against the will of the said plaintiff, did make, construct, and lay a large quantity of wooden pavement, all of which embodied and employed in its construction the said improvement, in breach of the said letters-patent, and of the right and liberty thereby granted as aforesaid, and in violation of the statutes of the United States in such case made and provided, and of the aforesaid rights of said plaintiff.

Whereby and by means of which grievances the said plaintiff has been greatly injured and deprived of great profits, which he might and would otherwise have derived from said improvement, to wit, at the district of California aforesaid, and has sustained actual damage to a large amount, to wit, the sum of five thousand dollars.

By means of which said premises, and by force of the statutes aforesaid, an action has accrued to the said plaintiff to recover of the said defendant the said actual damages, and such additional amount, not
11 exceeding in the whole three times the amount of the said actual damages, as the court may see fit to order and adjudge.

Yet the said defendant, although often requested, has never paid the same, or any part thereof, to the said plaintiff, but has refused and still refuses so to do, to the damage of the said plaintiff five thousand dollars, and therefore he brings suit, &c.

SHARPSTEIN & HASTINGS,
Attorneys for Plaintiff.

Endorsed: Filed Sept. 9, 1869.

GEO. E. WHITNEY,
Clerk,
By H. F. LARDNER,
Dep'y.

12 *Summons.*

UNITED STATES OF AMERICA:

In the circuit court of the United States in and for the district of California.

Action brought in the said circuit court, and the complaint filed in the office of the clerk of said circuit court, in the city of San Francisco.

CHARLES E. JENKINS, PLAINTIFF,
vs.
THE NICHOLSON PAVEMENT COMPANY, DEFENDANT.

The President of the United States of America greeting to the Nicholson Pavement Company:

You are hereby required to appear in an action brought against you by the above-named plaintiff in the circuit court of the United States for the district of California, and to file your plea, answer, or demurrer to the complaint filed therein, (a copy of which accompanies this summons,) in the office of the clerk of said court in the city and county of San Francisco, within ten days (exclusive of Sundays and day of service) after the service on you of this summons, if served in this county; or if served out of this county, then within forty days, or judgment by default will be taken against you.

The said action is brought to recover $5,000, actual damages sustained by the plaintiff, together with such additional sum, not exceeding
13 three times the amount of said actual damages, as the court shall order, for the breach of certain letters-patent, & in violation of the plaintiff's rights as assignee of said letters-patent; all of which will more fully appear by the complaint on file; and if you fail to appear and plead, answer, or demur, as herein required, judgment by default will be entered against you and each of you.

Witness the Honorable Salmon P. Chase, Chief Justice of the Supreme Court of the United States of America, this ninth day of September, in the year of our Lord one thousand eight hundred and sixty-nine, and of our independence the ninety-fourth.

(Signed) GEO. E. WHITNEY, *Clerk.*

SEAL OF THE U. S. CIRCUIT COURT, DIST. OF CAL'A.

(Endorsed:)

U. S. MARSHAL'S OFFICE,
District of California.

I hereby certify that I received the within summons on the 9th day of September, A. D. 1869, and personally served the same on the *same on the* 9th day of September, A. D. 1869, by delivering to A. P. Flint, secretary of said Nicholson Pavement Company, said defendant, personally, in the county of San Francisco, a copy of said summons attached to a certified copy of the complaint.

San Francisco, September 9th, 1869.

CHA'S W. RAND,
U. S. Marshal,
By GEO. T. WORTH, *Deputy.*

Filed Oct. 13, 1869.

GEO. E. WHITNEY, *Clerk,*
By H. F. LARDNER, *D. C.*

14 *Answer.*

In the circuit court of the United States for the district of California.

CHARLES E. JENKINS, PLAINTIFF,
vs.
THE NICHOLSON PAVEMENT COMPANY, DEFENDANT. } No. 824.

The above-named defendant, the Nicolson Pavement Company, for answer to the plaintiff's complaint in this action, alleges that long prior to the 14th day of August, A. D. 1868, the date of the said alleged assignment, made by George T. Bigelow, administrator of the estate of Samuel Nicolson, deceased, to Edwin C. Larned and Stephen A. Goodwin, to wit, on the 1st day of December, 1864, the said Samuel Nicolson, by an instrument of writing of that date, duly executed under his hand and seal, for a valuable consideration, sold, assigned, and set over unto Jonathan Taylor, of Milwaukie, in the State of Wisconsin, and his assigns, all the right, title, and interest of him, said Nicolson, for the city and county of San Francisco, in the State of California, in or to the invention mentioned in the complaint, and in or to the letters-patent mentioned in the complaint, bearing date the 8th day of August, A. D. 1854, for and during the whole term for which said letters-patent were granted, and for and during the whole term of any extension or renewal thereof; and said assignment is duly recorded in the Patent
15 Office of the United States, and was so recorded prior to said 14th day of August, A. D. 1868.

That afterwards, to wit, on the 8th day of July, A. D. 1865, the said Jonathan Taylor, for a valuable consideration, by an instrument in writing of that date, duly executed under his hand and seal, sold, assigned, and set over all the right, title, and interest in said invention and letters-patent, acquired as aforesaid, to one J. J. Robbins and his assigns, of said city and county of San Francisco; and said Robbins, afterwards, to wit, on the 9th day of May, 1866, in like manner, and by like instrument of writing, sold, assigned, and set over the same to this defendant, a corporation created and existing under the laws of the State of California, and having its principal place of business in said city and county of San Francisco, and to its successors and assigns, and that both of the said instruments of writing last hereinbefore mentioned are duly recorded in said Patent Office, and were so recorded prior to the said 14th day of August, A. D. 1868.

That on and prior to said 14th day of August, A. D. 1868, the plaintiff, as also the said Edwin C. Larned and Stephen A. Goodwin, through whom the plaintiff claims, had notice and knowledge of the said several assignments hereinabove stated.

That under and by force of the said several assignments, this defendant acquired, and ever since the said 9th day of May, A. D. 1866, has held, the exclusive right to use, and grant licenses to others to use, said invention and improvement within said city and county of San Francisco.

16 And this defendant denies that on said first day of September, A. D. 1868, or at any time since, it has, at said city of San Francisco, or elsewhere, made, constructed, or laid a large or any quantity whatever of wooden pavement, in the construction of which was embodied or employed the said invention or improvement.

And for a further and separate answer to the plaintiff's complaint in

this action, and for a further and separate defence against the cause of action therein stated, the defendant denies each and all the allegations of said complaint.

WILSON AND CRITTENDEN,
Attorneys for Defendant.

(Endorsed:) Service of a copy of the within answer admitted this 21st day of October, A. D. 1869.

SHARPSTEIN AND HASTINGS,
Attorneys for Plaintiff.

Filed October 21st, 1869.

GEO. E. WHITNEY, *Clerk.*
By H. F. LARDNER, *D. C.*

17 *Findings.*

FRIDAY, MARCH 4, 1870.

JENKINS
vs.
NICHOLSON PAVEMENT CO. } No. 824.

A jury having been waived by stipulation in writing filed in the cause, this cause came on for trial before the court without a jury, on the fourth day of March, upon the statement of facts agreed to by counsel of the respective parties, as hereinafter set forth, and the cause having been argued by counsel, and the court being sufficiently advised, now finds the following facts and conclusions of law, viz:

On the 8th of August, 1854, Samuel Nicholson, of Boston, obtained letters-patent for an improvement on wooden pavements, as alleged in the declaration of the plaintiff. On the first day of December, 1863, he obtained a reissue of the letters-patent. Afterwards, on August 20, 1867, he obtained another reissue of the same letters-patent on an amended specification. Afterwards, on the 6th of January, 1868, said Nicholson died intestate, and on 3d day of February, 1868, Geo. F. Bigelow was duly appointed and qualified as administrator of said Nicholson, and from thence hitherto he has continued such administrator. Afterwards, on the 7th of July, 1868, upon the application of said Bigelow, in capacity of administrator of said estate, the Commissioner of Patents duly renewed and extended said letters-patent for the term of seven years from the 8th day of August, 1868, under the 18th section of the act of July 4, 1836, and the act of Congress of May 27, 1848. Afterwards, on the 14th of August, 1868, said Geo. F. Bigelow assigned to Edwin C. Larned and Stephen A. Goodwin one-third of the right, title, and interest in said invention and patent for the State of California, and afterwards, on the same day, said Bigelow, Larned, and Goodwin assigned to Jonathan Taylor and the plaintiff in this action, jointly, all their right, title, and interest in said invention and patent for the State of California. And afterwards, on the 27th day of February, 1869, said Taylor assigned all his right, title, and interest in said invention and patent for the State of California to the plaintiff in this action. Since said 8th day of August, 1868, the defendant in this action, without leave or license from plaintiff, has laid down and constructed, in the city of San Francisco, in the State of California, ten thousand two hundred and twenty-two square yards of wooden pavement which embodied and employed in its constuction the inven-

tion for which said letters-patent were granted and extended as aforesaid; that the royalty fixed and established by said plaintiff for licenses to lay down said pavement in said city and county and State is thirty-one cents (31 cts.) in gold coin per square yard, and the plaintiff, if entitled to recover in this action, is entitled to judgment for the sum of three thousand one hundred and sixty-nine dollars in gold coin, ($3,169.)

19 On the first day of December, 1864, Samuel Nicholson, the patentee, executed and delivered to Jonathan Taylor an assignment in writing, of which the following is a copy:

"Whereas I, Samuel Nicolson, of Boston, in the State of Massachusetts, invented a certain new and useful improvement in wooden pavements, of which letters-patent of the United States of America (numbered 1,583 of reissued patents, and bearing date the first day of December, in the year eighteen hundred and sixty-three) have been granted to me, giving to me and my legal representatives the exclusive right of making, using, and vending the said invention throughout the said United States; the original patent being dated August 8, 1853, and given for the term of fourteen years:

"And whereas Jonathan Taylor, of the city of Milwaukie, in the State of Wisconsin, has agreed to purchase from me all the right, title, and interest which I have in and to the said invention for and in the city of San Francisco, in the State of California, as secured by the said letters-patent, and has paid to me the sum of one dollar, the receipt whereof is hereby acknowledged:

"Now, therefore, this indenture witnesseth, that for and in consideration of the said sum to me paid, I have assigned, sold, and set over, and do hereby assign, sell, and set over, unto the said Jonathan Taylor,

20 all the right, title, and interest which I have in the said invention and letters-patent for and in the said city of San Francisco, but in no other place.

"The same to be held and enjoyed by the said Taylor for the use and behoof of him and his legal representatives to the full end of the term for which the said letters-patent are or may be granted, as fully and effectively as the same would have been held and enjoyed by me had this assignment never been made.

"In testimony whereof I have hereunto set my signature and affixed my seal, this first day of December, A. D. 1864.

"SAMUEL NICOLSON. [SEAL.]

"Witness: JOSEPH WEST.

"Rec'd and recorded Sept. 25th, 1865.

"Ex'd, E. A.

[5. S. N. 1864, Dec. 1.]

(Endorsed:) "Jenkins vs. Nicholson Pav. Co., No. 1, L. S."

The patent referred to in this assignment was the same patent originally granted to Nicholson, though it is erroneously stated in the assignment to be August 8, 1853. This assignment was duly recorded in the office of the Commissioner of Patents on the 25th of September, 1865, and all the right which was vested in Jonathan Taylor under that assignment from Nicholson was assigned to and held by the defendant, The Nicholson Pavement Co., prior to the 8th of August, 1868, and has ever since been held by the company.

As conclusions of law, the court finds that the said assignment of December first, 1864, from said Nicholson to said Taylor, did not vest in

said Taylor, or his assigns, any right, title, or interest in the said
21 renewed and extended term of said patent, but only an interest in the original patent for the original term, and in such patents as were reissued for said original term; that said defendant derived no right to construct the said pavement in question in this action under or by virtue of said assignment, and that the plaintiff is entitled to judgment for said sum of three thousand one hundred and sixty-nine dollars in gold coin, and his costs of suit.

Let judgment be entered accordingly.

(Signed) LORENZO SAWYER,
Circuit Judge.

(Endorsed:) Filed 18th June, 1870.

GEO. E. WHITNEY, *Clk*,
By L. S. B. SAWYER, *D. C.*

22 *Judgment.*

In the circuit court of the United States, ninth circuit, district of California.

CHARLES E. JENKINS
vs.
THE NICHOLSON PAVEMENT COMPANY. } No. 824.

This cause having come on regularly for trial before the court, sitting without a jury, a trial by jury having been expressly waived by written stipulation of the parties, duly filed on the 4th day of March, A. D. 1870, being a day in the February term, 1870, of said court, J. R. Sharpstein, esq., appearing for the plaintiff, and A. P. Crittenden, esq., for the defendant, and proofs having been introduced and the evidence closed, and the cause having been submitted to the court for consideration and decision, and, after due deliberation thereon, the court having filed its finding in writing, and ordered that judgment be entered in accordance therewith:

Now, therefore, by reason of the law and the finding aforesaid, it is considered and adjudged that said Charles E. Jenkins, plaintiff, do have and recover of and from said Nicholson Pavement Company, defendant, the sum of three thousand one hundred and sixty-nine dollars, in gold coin of the United States, and his costs in this behalf expended, taxed at thirty-three dollars and forty cents.

Judgment entered this 20th day of June, A. D. 1870.

Attest:

GEO. E. WHITNEY, *Clerk*,
By L. S. B. SAWYER, *D. C.*

23 *Security on writ of error.*

Supreme Court of the United States.

THE NICOLSON PAVEMENT COMPANY, PLAINTIFF in error,
vs.
CHARLES E. JENKINS, DEFENDANT IN ERROR.

Know all men by these presents that we, The Nicolson Pavement Company, principal, and Charles E. McLane and Abraham Seligman, sureties, are held and firmly bound unto Charles E. Jenkins in the sum

of six thousand five hundred dollars, in gold coin of the United States, to be paid to the said Charles E. Jenkins, his executors or administrators, to which payment, well and truly to be made, we bind ourselves and each of us, jointly and severally, and our and each of our successors, heirs, executors, and administrators, firmly, by these presents.

Whereas the above-named "The Nicolson Pavement Company" has prosecuted a writ of error to the Supreme Court of the United States to reverse a judgment rendered in the above-entitled suit by the circuit court of the United States for the district of California:

Now, therefore, the condition of this obligation is such, that if the above-named "The Nicolson Pavement Company" shall prose-
24 cute its said writ of error to effect, and answer all damages and costs if it shall fail to make good its plea, then this obligation shall be void; otherwise the same shall be and remain in full force and virtue.

In testimony whereof the said "The Nicholson Pavement Company" has caused its corporate name to be hereunto subscribed, and its corporate seal to be hereunto affixed, by Charles E. McLane, its president, and Augustus P. Flint, its secretary, and the said Charles E. McLane and Abraham Seligman have hereunto subscribed their names and affixed their seals this 25th day of June, 1870.

"The Nicholson Pavement Company,"

{ NICHOLSON L. S. PAVEMENT CO. }

By CHA'S E. McLANE, *President.*
A. P. FLINT, *Secretary.*

CHA'S E. McLANE. [SEAL.]
AB'M SELIGMAN. [SEAL.]

The foregoing bond approved by me, this 25th day of June, 1870.
(Signed) LORENZO SAWYER,
Circuit Judge.

I hereby certify that Charles E. McLane and Abraham Seligman signed and acknowledged the foregoing bond in my presence, and each, for himself, being duly sworn, deposed and said that he is a householder in said district of California, and is worth the sum of six thousand five hundred dollars in gold coin of the United States, exclusive of property exempt from execution, and over and above all debts and liabilities.

L. S. B. SAWYER,
Comm'r U. S. Circuit Court, Ninth Circuit, District of California, to take acknowledgments, &c.

25 (Endorsed:) Filed 25th June, 1870.
GEO. E. WHITNEY, *Clerk.*

26 *Citation.*

UNITED STATES OF AMERICA, *ss:*

To Charles E. Jenkins, greeting:

You are hereby cited and admonished to be and appear at a Supreme Court of the United States, to be holden at Washington, on the first Monday of December next, pursuant to a writ of error filed in the clerk's office of the circuit court of the United States for the district of California, wherein "The Nicolson Pavement Company" is plaintiff and you are defendant in error, to show cause, if any there be, why the

judgment in said writ of error mentioned should not be corrected, and speedy justice should not be done to the parties in that behalf.

Witness the Honorable Lorenzo Sawyer, circuit judge, and one of the judges of the said circuit court of the United States for the district of California, this 25th day of June, 1870.

(Signed) LORENZO SAWYER, [SEAL.]
Circuit Judge, and one of the Judges of the Circuit Court of the United States for the District of California.

(Endorsed:) Service of a copy of the within citation admitted this 27th day of June, A. D. 1870.

SHARPSTEIN & HASTINGS,
Attorneys for Defendant in Error.

Filed this 28th June, 1870.

GEO. E. WHITNEY, *Clk.*
By L. S. B. SAWYER, *D. C.*

27 UNITED STATES OF AMERICA,
Ninth Circuit, District of California, ss:

I, George E. Whitney, clerk of the circuit court of the United States, ninth circuit, for the district of California, hereby certify that the foregoing twenty-two written pages, numbered from 1 to 22, both inclusive, are a true transcript of the record and proceedings in the cause therein entitled, and that the same together constitute the return of the writ of error hereto annexed.

In testimony whereof I have hereunto set my hand and the seal of said circuit court, this 30th day of June, in the year of our Lord one thousand eight hundred and seventy, and of our independence the ninety-fourth.

[SEAL.] GEO. E. WHITNEY, *Clerk.*

(Indorsement on cover:) No. 482. The Nicholson Pavement Company, plaintiff in error, vs. Charles E. Jenkins. California C. C. U. S.
Filed 6th September, 1870.

No. 63.

IN THE

SUPREME COURT OF THE UNITED STATES.

THE NICHOLSON PAVEMENT COMPANY,
Plaintiff in Error,

vs.

CHARLES E. JENKINS.

Brief for Plaintiff in Error.

R. J. BRENT,
T. T. CRITTENDEN, } *Of Counsel.*

H. Polkinhorn & Son, prs., D Street, near 7th.

Supreme Court of the U. States.

THE NICHOLSON PAVEMENT COMPANY,
Plaintiff in Error
vs.
CHARLES E. JENKINS.

Brief for Plaintiff in Error.

The plaintiff in error claims, as assignee of J. J. Robbins, who was assignee of Jonathan Taylor to whom Samuel Nicholson the patentee assigned.

The defendant in error claims, as assignee of Jonathan Taylor, who, with said defendant was assignee of Edwin C. Larned and Stephen A. Goodwin, who were assignees of George F. Bigelow, administrator of Samuel Nicholson, deceased. The facts are stated in the findings of the Court below, as follows:

Findings:

FRIDAY, MARCH 4, 1870.

JENKINS
vs.
NICHOLSON PAVEMENT CO. } No. 824.

A jury having been waived, by stipulation in writing filed in the cause, this cause came on trial before the court without a jury, on the fourth day of March, upon the statement of facts agreed to by counsel of the respective parties, as hereinafter set forth, and the cause having been argued by counsel, and the court being sufficiently advised, now finds the following facts and conclusions of law, viz:

On the 8th of August, 1854, Samuel Nicholson, of Boston, obtained letters-patent for an improvement on wooden pavements, as alleged in the declaration of the plaintiff. On the first day of December, 1863, he obtained a reissue of the letters-patent. Afterwards, on August 20, 1867, he obtained another reissue of the same letters-patent on an amended specification. Afterwards, on the 6th

of January, 1868, said Nicholson died intestate, and on the 3d day of February, 1868, George F. Bigelow was duly appointed and qualified as administrator of said Nicholson, and from thence hitherto he has continued such administrator. Afterwards, on the 7th of July, 1868, upon the application of said Bigelow, in capacity of administrator of said estate, the Commissioner of Patents duly renewed and extended said letters-patent for the term of seven years from the 8th day of August, 1868, under the 18th section of the act of July 4, 1836, and the act of Congress of May 27, 1848. Afterwards, on the 14th of August, 1868, said Geo. F. Bigelow assigned to Edward C. Larned and Stephen A. Goodwin one-third of the right, title, and interest in said invention and patent for the State of California, and afterwards, on the same day, said Bigelow, Larned, and Goodwin assigned to Jonathan Taylor and the plaintiff in this action, jointly, all their right, title, and interest in said invention and patent for the State of California. And afterwards, on the 27th day of February, 1869, said Taylor assigned all his right, title, and interest in said invention and patent for the State of California to the plaintiff in this action. Since said 8th day of August, 1868, the defendant in this action, without leave or license from plaintiff, has laid down and constructed, in the city of San Francisco, in the State of California, ten thousand two hundred and twenty-two square yards of wooden pavement which embodied and employed in its construction the invention for which said letters-patent were granted and extended as aforesaid; that the royalty fixed and established by said plaintiff for licenses to lay down said pavement in said city and county and State is thirty-one cents (31 cts,) in gold coin per square yard, and the plaintiff, if entitled to recover in this action, is entitled to judgment for the sum of three thousand one hundred and sixty-nine dollars in gold coin, ($3,169.)

On the first day of December, 1864, Samuel Nicholson, the patentee, executed and delivered to Jonathan Taylor an assignment in writing, of which the following is a copy:

"Whereas I, Samuel Nicholson, of Boston, in the State of Massachusetts, invented a certain new and useful improvement in wooden pavements, of which letters-patent of the United States of America (numbered 1,583 of reissued patents, and bearing date the first day of December, in the year eighteen hundred and sixty three) have been granted to me, giving to me and my legal representatives the exclusive right of making, using, and vending the said invention throughout the said United States; the original patent being dated August 8, 1853, and given for the term of fourteen years:

"And whereas Jonathan Taylor, of the city of Milwaukie, in the State of Wisconsin, has agreed to purchase from me all the right, title, and interest which I have in and to the said invention for and in the city of San Francisco, in the State of California, as secured by the said letters-patent, and has paid to me the sum of one dollar, the receipt whereof is hereby acknowledged:

"Now, therefore, this indenture witnesseth, that for and in consideration of the said sum to me paid, I have assigned, sold, and set over, and do hereby assign, sell, and set over, unto the said Jonathan Taylor, all the right, title, and interest which I have in the said invention and letters patent for and in the said city of San Francisco, but in no other place.

"The same to be held and enjoyed by the said Taylor for the use and behoof of him and his legal representatives to the full end of the term for which the said letters patent are or may be granted, as fully and effectively as the same would have been held and enjoyed by me had this assignment never been made."

"In testimony whereof I have hereunto set my signature and affixed my seal, this first day of December, A. D. 1864.

"SAMUEL NICHOLSON. [SEAL.)

"Witness: JOSEPH WEST.

"Rec'd and recorded Sept. 25th, 1865.

"Ex'd, E. A.

[5. S. N. 1864, Dec. 1.]

(Endorsed:) "Jenkins vs. Nicholson Pav. Co., No. 1, L. S."

The patent referred to in this assignment was the same patent originally granted to Nicholson, though it is erroneously stated in the assignment to be August 8, 1853. This assignment was duly recorded in the office of the Commissioner of Patents on the 25th of September, 1865, and all the right which was vested in Jonathan Taylor under that assignment from Nicholson was assigned to and held by the defendant, the Nicholson Pavement Co., prior to the 8th of August, 1868, and has ever since been held by the company.

As conclusions of law, the Court finds that the said assignment of December first, 1864, from said Nicholson to said Taylor did not vest in said Taylor, or his assigns, any right, title, or interest in the said renewed and extended term of said patent, but only an interest in the original patent for the original term, and in such patents as were reissued for said original term; that said defendant derived no right to construct the said pavement in question in this action under or by virtue of said assignment, and that the plaintiff is entitled to judgment for said sum of three thousand one hundred and sixty-nine dollars, in gold coin, and his costs of suit.

Let judgment be entered accordingly.

(Signed,) LORENZO SAWYER.
Circuit Judge.

(Endorsed:) Filed 18th June, 1870.

GEO. E. WHITNEY, *Clerk.*
By L. S. B. SAWYER, *D. C.*

Points.

1. The Commissioner of Patents was authorized to grant extensions for seven years, and the original letters patent then became virtually a patent for twenty-one years.

5 U. S. Statutes, p. 124, sec. 18.

Gibson *vs.* Harris, 1 Blatchf. 169.

Woodworth *vs.* Edwards, 2 Woodb. & Minof, 125.

2. The inchoate right of the inventor to the exclusive privileges under an extension of letters patent is the subject of a sale.

Wilson *v.* Rensseau, 4 Howard, 646.

Wilson *v.* Turner, Taney's C. C. Rep., 278.

Affirmed, 4 Howard, 712.

Clum *v.* Brewer, 2 Curtis, C. C. Rep., 506.

Day *v.* Candee, 3 Fisher, 9.

Aiken *v.* Dolan, 3 Fisher, 197.

Hartshorn *vs.* Day, 19 How., 220.

3. The words of the assignment, "I have assigned, sold, and set over, and do hereby assign, sell, and set over unto the said Jonathan Taylor, all the right, title, and interest which I have in the said invention and letters patent for and in the said City of San Francisco, but in no other place, the same to be held and enjoyed by the said Taylor for the use and behoof of him and his legal representatives to the full end of the term for which the said letters patent are or may be granted, as fully, and effectively as the same would have been held and enjoyed by me had this assignment never been made," (Rec. p. 8,) are applicable only to a design to convey both a present and future interest.

This construction has repeatedly been given to contracts expressed in similar language.

1. In Phelps *v.* Comstock, 4 McLean, 354–5, Judge McLean held that the words "to the full end of the term or terms for which letters patent are or may be granted for said improvements as fully and entirely as the same would have been enjoyed by me had this assignment not been made," conveyed an interest in the extended term.

2. In Case *v.* Redfield, 4 McLean, 528–9, Judge Huntington decided "That a grant of all the right, title and interest which said heirs had in said invention and improvement as secured to them by said letters patent for the whole United States, with certain exceptions, and for the use and behoof of his (Zebulon Parker's) representatives for which letters patent were, or *may be granted* for said improvements, as fully and entirely as the

same would have been held and enjoyed by said heirs had that assignment not been made," gave a right to the extension.

3. In Nesmith *v.* Calvert, 1 Woodbury & M., 34, Judge Woodbury held that a grant of "all improvements in machines for burring wool, and all my right to any letters patent which may be obtained for the same," would extend to a second as well as a first patent.

4. Judge Curtis, in Clum *v.* Brewer, 2 Curtis, 507, &c., decided that Morse, who had filed a caveat and then conveyed "one-fourth of my invention and of all my right and property therein secured by my caveat or otherwise, that I have *or may have* from any letters patent for the same, granted by the Government of the United States," granted thereby an interest in the extension of his patent.

5. Judge Story, in Woodworth *v.* Sherman, 3 Story, 174, &c., and Mitchell *v.* Winslow, 2 *id.* 639, held that when the grant by express words or just implication, gives an interest in the renewed patent, the assignee will be protected.

6. Judge Cadwalader, in Chase *v.* Walker, 3 Fisher, 123, said: "Independently of the contingency of an extension, the term could be neither less nor greater than the original fourteen years. Therefor, independently of this contingency, there could be no such comparative duration as to satisfy the words "utmost and fullest extent." The applicability of this remark is not excluded by the addition of the words "under said letters patent." In the reports of cases which have been cited in the argument, the original patent is, after an extension considered as having been from the first, for certain purposes a patent for the extended term.

See also Bloomer *v.* Millingri, 1 Wall, 340.

Com'r. of Patents *v.* Whitely, 4 Wall, 522.

Brooks et al. *v.* Bickwell et al., 4 McLean, 64.

Act July 4, 1836, 5 U. S. Statutes at Large, 117.

The assignment is to be construed in the sense in which both parties understood and intended it at the time it was made, and to secure to the purchaser the right which he intended to buy, and supposed he had bought, and which the patentee must have intended to sell and at the time of the contract must have supposed he had sold.

Also in its construction, effect is to be given, if possible, to every clause of the contract.

It will be observed that the patentee, Nicholson, died before the extension was made, and that Jonathan Taylor, after selling to Rob-

bins, who conveyed to the plaintiff in error, bought the extension from the administrator and conveyed the same to the defendant in error. This has the appearance of a sharp operation upon the part of Taylor.

It is submitted, that the true construction of the said assignment by Nicholson to Taylor dated, December 1, 1864, clearly establishes the intention of one to buy and the other to sell a local interest in and to Nicholson's invention to the fullest extent as to duration which said patentee then had or might thereafter obtain.

R. J. BRENT,
T. T. CRITTENDEN,
Of Counsel.

No......

In the Supreme Court

OF THE

United States.

THE NICOLSON PAVEMENT COMPANY,

PLAINTIFF IN ERROR,

VS.

CHARLES E. JENKINS,

DEFENDANT IN ERROR.

Brief of Defendant in Error.

J. R. SHARPSTEIN,

Of Counsel.

SAN FRANCISCO:

WADE & CO., STEAM BOOK AND JOB PRINTERS, 411 CLAY STREET.

1870.

In the Supreme Court of the United States.

THE NICOLSON PAVEMENT COMPANY,
Plaintiff in Error,

v.

CHARLES E. JENKINS,
Defendant in Error.

BRIEF OF DEFENDANT IN ERROR.

The parties respectively claim to have acquired from Nicolson the exclusive right to the patent for the renewed or extended term, in the city of San Francisco.

The plaintiff in error derives whatever right or claim it has to the extended term from an assignment of Nicolson to Taylor, made December 1st, 1864, and nearly four years before the original term, for which the patent was granted, expired.

The assignment to the defendant in error is of the extended or renewed term, and it is conceded that it vests in him the right to it, unless the assignment of Nicolson to Taylor, under the former term, embraced the extended as well as the original term. So that it is only important, now, to ascertain whether the assignment of Nicolson to Taylor, contains any provision looking to an interest beyond that which the patentee had then already secured.

R Rem 10 Wall 376

If not, we may safely assume that those claiming under Taylor take nothing under the extension.

Wilson v. *Rousseau*, 4 *How.* 682.

Bloomer v. *McQueewen*, 14 *How.* 549.

Curtis on Patents, § 203.

After reviewing all the cases bearing upon the point, CURTIS says:

"The conclusion, therefore, to which the cases, as well as sound principle, lead, is this, that the only presumption applicable to such instruments is that the parties dealt for the existing term, unless a provision was inserted in the grant or assignment looking to a further interest."

Curtis on Patents, § 209.

Gibson v. *Cooke*, 2 *Blatch.* 144.

In *Bloomer* v. *McQueewen*, (14 *How.* 549) CH. J. TANEY, delivering the opinion of the Court, says: "The franchise which the patent grants, consists altogether in the right to exclude everyone from making, using, or vending the thing patented without the permission of the patentee. This is all that he obtains by the patent. And when he sells the exclusive privilege of making or vending it for use in a particular place, the purchaser buys a portion of the franchise which the patent confers * * * * * *. And the interest which he acquires, necessarily terminates at the time limited for its continuance by the law which created it. The patentee cannot sell it for a longer time, and the purchaser buys with reference to that period; the time for which exclusive privilege is to endure, being one of the chief elements of its value. He therefore has no just claim to share in a further monopoly, subsequently acquired by the patentee. He does not purchase or pay for it."

In *Clum* v. *Brewer*, (2 *Curtis, C. C. Reps.* 520–521,) MR. JUSTICE CURTIS says: "A sale of the invention before Letters Patent are obtained, does not necessarily carry with it the exclusive right for the extended term, because this right is not a mere incident of the invention; its existence

is made to depend, not only on matter which is subsequent to the invention, but exclusively personal to the inventor himself; and only he or his personal representatives can obtain it."

"So far, therefore, as the legitimate influence of this policy of the law can extend, in the construction of a contract of sale of the invention, it should undobtedly be held, that unless an intention to convey something beyond the first term can be found in the instrument, the assignee should not be held to take anything beyond that term."

Curtis on Patents, § 208.

In the assignment of Nicolson to Taylor no allusion is made to an extension or renewal of the patent for a further term, and the interest assigned is clearly that, and that alone, which the patentee had already acquired.

I. It recites the re-issue of the patent in 1863, the original of which had been issued to the patentee in 1854 for the term of 14 years.

II. That Taylor had agreed to purchase of Nicolson all the right, title and interest which Nicolson had in and to the said invention for and in the City of San Francisco, "as secured by the said Letters Patent."

III. That Nicolson assigned to Taylor all the right, title and interest which he, Nicolson, had—"which I have" is the exact expression—"in the said invention and Letters Patent for and in the said City."

IV. "The same to be held and enjoyed by the said Taylor for the use and behoof of him and his legal representatives to the full end of the term, for which the said Letters Patent are or may be granted."

But what was the interest "to be held and enjoyed" by the assignee "and his legal representatives to the full end of the term for which the said Letters Patent are or may be granted?" Clearly the interest which had been before defined in the instrument. The clause refers back to that. It is, "*the same* to be held," etc. And that interest is uniformly described in the instrument as one which the pa-

tentee had already secured. "As secured by the said Letters Patent" is the expression used. The interest assigned is expressly limited to that which the patentee had then secured. That was to be held and enjoyed to the full end of the term. No reference is made to a future contingent interest, or to a second term.

Everything in this assignment down to the last or *habendum* clause, and everything in that, except the words "or may be" points clearly and unmistakably to the then existing term as the one which the parties had solely in view at the time.

As this patent was granted under the Act of 1836, the parties must be presumed, according to the rule laid down by this Court in *Wilson* v. *Rousseau*, to have covenanted with reference to the known and existing rights of the patentee under that act. Now under that act there might be an indefinite number of new patents issued during the first term. The 13th Section of that act speaks of a re-issued patent as a "*new* patent," and the practice under this Section was, whenever a re-issue was determined upon, to issue new Letters Patent, so that during and within the original term several Letters Patent might be granted. And that is clearly what the parties contemplated. For the 18th Section, which provided for extensions by the Commissioner, describes the further term so obtained, by the terms "extension" and "renewal," and upon granting such extension or renewal of the patent, the Commissioner simply made "a certificate thereon of such extension," but did not issue any new Letters Patent. As the renewal or extension did not involve the issuing or granting of additional Letters Patent, the reference in the assignment to Letters Patent, which had been or might be granted, is not indicative of an intention to include in the assignment, rights which could only be acquired by an extension or renewal, and which it was well settled at the time would not pass to the assignee under the former term in the absence of an express stipulation to that effect.

The renewal created a second term. The law expressly says that it shall be, "for the term of seven years from and after the expiration of the *first term*." The reference in the assignment is to a single term, and of course to the then existing term.

As the Court says in *Wilson* v. *Rousseau*, (4 *How.* 685): "If the parties in this case contemplated any alteration or modification of their rights, more advantageous, by the further action of Congress, (by the further action of the Commissioner in this case,) we think some more specific provision having reference to it should have been inserted in their covenant."

In this case the first term would expire in less than four years after the date of the assignment, while the second term, if one should be created by a renewal, would continue for seven years thereafter, and yet the parties omitted to insert any specific provision in regard to the second term, which we may safely assume to have been at that time, in their estimation at least, of double the value of the then residue of the first term.

In the recent case of *Hodge* v. *The Hudson R. R. Co.* (not reported) JUDGE BLATCHFORD says: "The provision that the license is to continue during the term, for which said Letters Patent are or may be granted, is satisfied by holding it to apply exclusively to a re-issue of the patent."

The cases relied upon by the defendant in the Court below, were *Clum* v. *Brewer*, 2 *Curtis, C. C.* 519; *Phelps* v. *Comstock*, 4 *McLean*, 353, and *Case* v. *Redfield*, 4 *McLean*, 526.

In *Clum* v. *Brewer*, the Court says: "At the date of the deed no Letters Patent had been obtained. The deed could not convey and does not purport to convey an interest in any particular Letters Patent, or in any exclusive right secured by any particular Letters Patent. It purports to convey one undivided fourth part of the invention." The deed in that case conveyed all the right, title and interest in and to one undivided fourth of the inven-

tion which the grantor then had, or might have from any Letters Patent for the same, and constituted the grantee a joint owner with the grantor therein; to receive his proportion of the proceeds of sale of rights to use said invention in any place or country which might accrue to the grantor at any time. There were other contemporaneous and subsequent agreements between the grantor and grantee, which, in the judgment of the Court, strengthened the conclusion that the parties dealt with reference to the second term.

In *Phelps* v. *Comstock*, MR. JUSTICE MCLEAN held that an assignment of all the assignor's right, title, etc., to the patent and improvement to be held and enjoyed to the full end of the *term or terms*, for which Letters Patent had been or might be granted, clearly embraced any subsequent renewal of the patent.

In *Case* v. *Redfield*, the interest assigned is not limited to the term for which Letters Patent are or may be granted. And MR. JUSTICE MCLEAN held that the parties then might have supposed that a new grant would be issued for the extended term. And he likewise held that the words used in that assignment could not be made to apply to any reissue of the patent upon the correction of a supposed error, in the specifications or claims of the patent, because as the law then stood, a patent was not void for claiming more than was invented.

And it is worthy of remark that in both of the cases decided by MR. JUSTICE MCLEAN the claims of the assignees were not contested by the patentees, nor any one claiming under them. The defendants in those cases were mere naked infringers, without a shadow of claim to the patent. It did not appear that the assignors questioned the claim set up by their assignees to the extended term, and might therefore be presumed to acquiesce in it.

And MR. JUSTICE CURTIS in *Clum* v. *Brewer*, after expressing the opinion that the parties had in view when they entered into the contract, the extended as well as the

first term, adds: "Nor do I understand that Professor Morse has at any time, or does now, take a different view of the matter."

In this case the claim of the plaintiff in error has not been recognized by the patentee or his representatives in any manner.

Whether the decisions of MR. JUSTICE MCLEAN, in the cases above referred to, can be reconciled with the rule of construction, laid down by this Court in *Wilson* v. *Rousseau*, or not, is not for us to say. It is sufficient for our purpose that the cases differ so materially from this as to deprive them of any weight, as authorities upon the proper construction of the assignment in this case.

We append hereto the opinion of the Judge before whom the case was tried at the Circuit.

J. R. SHARPSTEIN,
Of Counsel.

Matt. H. Carpenter

APPENDIX.

In the Circuit Court of the United States,

FOR THE DISTRICT OF CALIFORNIA.

CHARLES E. JENKINS,

vs.

THE NICOLSON PAVEMENT COMPANY.

OPINION.

SAWYER, J.

This is an action to recover the royalty established by the patentee for license to lay down the pavement known as the Nicolson Pavement. In 1854, Samuel Nicolson obtained letters patent for an improvement in wooden pavements. In December, 1863, he obtained a re-issue of the letters patent. In December, 1864, said Samuel Nicolson executed the following assignment of an interest in said invention and letters patent to Jonathan Taylor, viz:

Whereas, I, Samuel Nicolson, of Boston, in the State of Massachusetts, invented a certain new and useful improvement in wooden pavements, for which letters patent of the United States of America (numbered 1,584 of Re-issued Patents, and bearing date the first day of December, in the year 1863), have been granted to me, giving to me and my legal representatives the exclusive right of making, using and vending the said invention throughout the United States, the original patent being dated August 8, 1853, and given for the term of 14 years.

And whereas, Jonathan Taylor, of Milwaukee, in the State of Wisconsin, has agreed to purchase from me all the right, title and interest which I have in and to the said invention, for and in the

City of San Francisco, in the State of California, as secured by the said letters patent, and has paid to me the sum of $1, the receipt whereof is hereby acknowledged. Now, therefore, this indenture witnesseth, that for and in consideration of the said sum to me paid, I have assigned, sold and set over, and do hereby assign, sell and set over unto the said Jonathan Taylor, all the right, title and interest which I have in said invention and letters patent, for and in the said City of San Francisco, but in no other place. The same to be held and enjoyed by the said Taylor, for the use and behoof of him and his legal representatives, to the full end of the term for which the said letters patent are or may be granted, as fully and effectively as the same would have been held and enjoyed by me had this assignment never been made.

In testimony whereof, I have hereunto set my signature and affixed my seal, this 1st day of December, A. D. 1864.

SAMUEL NICOLSON.

The patent referred to in said assignment is the same patent issued to Nicolson in 1854, erroneously referred to as issued in 1853, and re-issued in 1863. Taylor, prior to August, 1868, assigned all his interest in said patent, acquired under said assignment to the Nicolson Pavement Company, defendant in this suit, and the said interest was held by said defendant at the time of the commencement of this suit.

In August, 1867, said Nicolson obtained another re-issue of the said letters patent on an amended specification. Nicolson having subsequently died in January, 1868, and Geo. T. Bigelow having been appointed his administrator, said Bigelow, in his said character of administrator, in July, 1868, procured from the Commissioner of Patents, a renewal or extension of said letters patent for seven years from August 8, 1868, in pursuance of the 18th section of the Act of Congress of July 4, 1836, and of May 27, 1848. Afterward the plaintiff acquired through assignment from said Bigelow as administrator, made on the 14th of August, 1868, all his right, title and interest in said invention and patents for the State of California. Since said 14th of August, 1868, the defendant, without leave or license of plaintiff, has constructed and laid down in the city of San Francisco, a large amount of pavement, employing in its construction the invention for which said letters patent were issued.

The question in this case is, whether the assignment from Nicolson to Jonathan Taylor of December 1, 1864, set out in the statement of facts, vested any estate, right, title or interest in the assignee, in or to the extended or renewed term, which was acquired by Bigelow as administrator under the Act of Congress, subsequent to the date of said assignment. It is quite clear that an assignment of an interest in an invention, and letters patent therefor, before the expiration of the original term, carries with it no interest in a subsequently extended term, unless it contains a specific provision to

that effect. (Wilson *vs.* Rousseau, 4 How. U. S. Sup. Ct. 646; Bloomer *vs.* McQuewen, 14 How. 549; Brooks *vs.* Bicknell, 4 McLean, 64; Phelps *vs.* Comstock, ib. 355; Clum *vs.* Brewer, 2 Curt. 520; Curtis on Patents, secs. 203, 208-9; Gibson *vs.* Cook, 2 Blatch. 146; Woodworth *vs.* Sherman, 3 Story, 171; Hodge *et al. vs.* Hudson River Railroad Co., and Hodge *vs.* N. Y. & H. R. R. Co. by Judge Blatchford, and same cases on further hearing in MSS.)

Does the Assignment in question contain any stipulation for an interest in any extended term that might be acquired by the patentee under the Acts of Congress? To my mind it plainly does not. The assignment recites the re-issuing of a patent for an improvement in wooden pavements in 1863, that the original patent was issued in 1853, and was "given for a term of fourteen years;" that said Jonathan Taylor had agreed to purchase all his right, title and interest 'in and to the said invention' for the city of San Francisco, in the State of California, '*as secured by said Letters Patent*,' the payment of the consideration, etc., and that in consideration, etc., 'I have assigned, sold and set over * * * * all the right, title and interest which I have in the *said* invention, and *Letters Patent* for and in the said city of San Francisco, but in no other place, the same to be held and enjoyed by the said Taylor * * * to the full end of *the term* for which 'the said Letters Patent *are* or *may be* granted,' etc. That is to say, the recitals show that the original patent had been issued for the term of 14 years, and that before the expiration of the term there had been a re-issue of the patent; that Taylor had agreed to purchase a certain interest in said invention, '*as* secured by *said* Letters Patent' (the Letters Patent recited, and not some others that might afterwards be issued for another term; no allusion is made to any further renewal); that in consideration of the premises he has assigned, sold and set over to said Taylor his interest 'in the *said* invention *and Letters Patent*"—the Letters Patent thereinbefore mentioned. Thus far there is not a word that can be tortured into an allusion to any term or Letters Patent other than the original term of 14 years, and the Letters Patent originally issued, and the re-issued letters recited.

These form the entire subject matter of the contract. There can be no doubt as to the intention of the parties, unless certain words in the habendum clause, contrary to the ordinary rules of construction, can be construed as extending the contract to a subject matter not before embraced, or referred to, in the recitals or granting portions of the deed. As we have seen, the habendum clause is, "the same to be held and enjoyed * * * to the full end of *the term* for which the *said* Letters Patent are or *may* be granted." The words "may be granted" are the only ones in the whole instrument that can possibly be thought to point to an extension that might subsequently be acquired. But they must be read in connection with, and in subordination to, the use of the instrument, and this very clause refers to "*the term* for which the *said* Letters Patent,"

etc., a single term is referred to and the *said* Letters Patent. The reference is in terms to the term and the Letters Patent already mentioned. The phrase "may be granted," seems to be an expression loosely used, and without any definite meaning in the connection in which it is found, unless it refers to other re-issues of patents covering the remainder of said term. There had already been one re-issue, and the facts show that a second re-issue was had for the remainder of the term after this assignment, doubtless to cover some defect. These re-issues are authorized by the Act of Congress, and often occur. In a certain sense, when the patents thus originally issued are surrendered and others issued in their place, the whole may be regarded as the same Letters Patent. They cover the same term. The re-issued patent covers no improvement or extension, but is intended to rectify some error, or remedy some defect and accomplish the indentical object intended to be accomplished by the letters originally issued. In this sense they are substantially the same letters patent. In this view the words "may be granted" may have some significance as used in this instrument, and they are satisfied by applying them to any further letters patent that might be issued for the same term and to accomplish the same objects intended by those already issued. And in this instance there was a subsequent re-issue for the remainder of the term, to which they might in fact apply. But upon a view of the whole instrument, to construe them as referring to a new term, and letters patent not yet *in esse*, would be doing great violence to the language. I have found no authority to justify such a construction. The language in the cases of Phelps *vs.* Comstock (4 McLean 64), Clum *vs.* Brewer (2 Curtis 520), and Case *vs.* Redfield (4 McLean 526), is entirely different. The last case comes the nearest to the present, but in that, the language supposed to indicate an intention to include any extension or renewal that might be granted is found in the granting clause, and there are no limiting or restrictive words pointing unmistakably to the single term then unexpired, and the letters patent granted for that term. In the assignment from Nicolson to Taylor there are no apt words to indicate an intention that an interest in any extension or renewal should pass, while on the other hand there are words of limitation constantly referring back to the term already in existence, and to the letters patent issued for that term, which had alone been mentioned in the recitals and granting clause. It is highly improbable that parties contemplating a sale of an interest in an extension, or renewal, would have adopted the language used in this assignment. I am satisfied that it was not intended to assign any interest in any extension or renewal that might afterward be acquired by the patentee. The terms of the contract are fully satisfied by an interest in the term then granted and the Letters Patent already issued, and any re-issued Letters for the same term.

Judgment, therefore, must be entered for the plaintiff.